

Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450

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| Application Number | 09/698,121 |
| Filing Date | October 30, 2000 |
| First Named Inventor | Jerome AUCOUTURIER |
| Art Unit | 1644 |
| Examiner Name | Gerald R. Ewoldt |
| Attorney Docket No. | 58771.000012 |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this appeal.

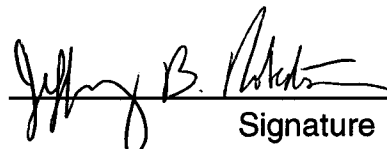
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided

I am the:

☐ Applicant/Inventor


Signature

☐ Assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96).

Jeffrey B. Robertson
Typed or printed name

☒ Attorney or Agent of Record 59,122
(Reg. No.)

202/419-2118
Requester's telephone number

☐ Attorney or Agent acting under 37 CFR 1.34.
Registration No. if acting under 37 CFR 1.34 _____

February 2, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 4 pages are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|-------------------------------|---|----------------------------|
| In re Patent Application of : |) | |
| |) | |
| Jerome AUCOUTURIER et al. |) | |
| |) | |
| Serial No.: 09/698,121 |) | Art Unit: 1644 |
| |) | |
| Filed: October 30, 2000 |) | Examiner: Gerald R. Ewoldt |

For: NOVEL VACCINE COMPOSITION AND USE OF SURFACTANTS AS
ADJUVANTS OF IMMUNITY

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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicant hereby requests a pre-appeal brief conference in the above-referenced patent application.

U.S. Patent No. 6,274,149 Omits an Essential Element of Claims 19, 20, 30, 31, and 33.

In the final rejection of August 2, 2006, claims 19, 20, 30, 31 and 33 were rejected under 35 U.S.C. § 102(e)¹ as allegedly being anticipated by U.S. Patent No. 6,274,149 (“the ‘149 patent”). However, in this rejection the Office has omitted one or more essential elements needed for a prima facie case. Specifically, the Office has failed to identify where the ‘149 patent teaches the elected species of an ethoxylated mannitan oleate having 8 ethoxy units.

The present invention relates to a method of providing an adjuvant effect to a vaccine comprising among other components, a mixture of surfactants having an overall HLB number of between 5 and 15, where the surfactants comprise ethoxylated derivatives of esters of fatty acids

¹ In the Final Office Action of August 2, 2006, the claims are rejected under 35 U.S.C. §102(b). However, the Office has quoted 35 U.S.C. §102(e)(1). Since the instant application was filed on October 30, 2000 and U.S. Patent No. 6,274,149 has a publication date of August 14, 2001, it qualifies as prior art under 35 U.S.C. §102(e) and not 35 U.S.C. §102(b).

having 12-22 carbon atoms with sorbitan or mannitan having a number of EOs of between 1 and 60; or ethoxylated derivatives of oils having a number of EOs between 1 and 60. By virtue of an Election of Species Requirement, which was maintained and made final by the Office, Applicants elected **mannitan oleate with 8 EO units**. (See Applicants' Responses of November 2, 2006, paragraph bridging pages 2-3 and July 17, 2006, page 3, first paragraph, for further discussions of the restriction requirement.)

Therefore, in order to reject the examined claims under 35 U.S.C. § 102(e), the Office was required to demonstrate that the prior art teaches all of the required claim limitations including the limitation of **mannitan oleate that had been ethoxylated with 8 ethylene oxide units**. The '149 patent does not teach the recited polyethoxylated mannitan oleate, specifically a polyethoxylated mannitan oleate with 8 EO's. (See Applicants' Responses of November 2, 2006, paragraph bridging pages 3-4 and July 17, 2006, page 2-3, for further discussions of the rejection under 35 U.S.C. § 102 (e).)

Applicants submit that there is a clear error in the rejection as Office has failed to identify the specific teaching in the '149 patent that sets forth the presence of 8 EO units, which is required for a prima facie case of anticipation under 35 U.S.C. § 102(e). Paragraph 4 of the Final office action of August 2, 2006 states that the "reference further teaches that the composition may be polyethoxylated (column 4, line 25), modified with ethylene oxide (column 4, line 48), or ethoxylated (column 4, line 53)." The office action also states that the reference "clearly anticipates" the claimed invention. However, the office action **fails to mention the EO number of 8**, to which Applicants have been restricted. Further, the '149 patent does not recite the elected limitation of an ethoxylated mannitan oleate, much less an ethoxylated mannitan oleate containing an EO number of 8. Applicants note that even if not limited to the elected species of ethoxylated mannitan oleate with an EO number of 8, the present claims still would not be anticipated as the reference does not teach ethoxylated mannitan oleates.

In view of the foregoing, it is respectfully submitted that the rejection of claims 19, 20, 30, 31, and 33 is in error. Accordingly, for the foregoing reasons, Applicant requests an appeal conference be convened so as to advise Applicant whether the Office will: 1) allow the present claims; 2) reopen prosecution and issue a new office action; or 3) allow this case to proceed to appeal.

Please charge any shortage in fees due in connection with the filing of this communication to Deposit Account No. 50-0206, and please credit any excess fees to such deposit account.

Respectfully submitted,

HUNTON & WILLIAMS

Dated: February 2, 2007

By:

A handwritten signature in dark ink, appearing to read "Robert M. Schulman", is written over a horizontal line.

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